

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 23, 2006. At the time of the Office Action, Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 were pending in this Application. Claims 3, 9, 12, 16 and 23 were previously cancelled without prejudice. Claims 1, 2, 4-8, 10, 11, 13-15, and 17-22 stand rejected. Applicant amends Claims 1 and 10, and respectfully requests reconsideration and favorable action in this case.

Claim Rejections under 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of U.S. Patent 6,208,345 issued to Nicolas C. Sheard et al. ("Sheard") and further in view of U.S. Patent 6,466,971 issued to Richard Humpleman et al. ("Humpleman"). Applicant respectfully disagrees with this rejection.

Claims 2, 4-6, 10, 11, 13-15, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Sheard in view of Humpleman as applied to Claim 1 above, and further in view of U.S. Patent 6,549,922 issued to Alok Srivastava et al. ("Srivastava et al."). Applicant respectfully disagrees with this rejection.

Claims 7, 8, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art and Sheard in view of Humpleman, as applied to Claim 1 above, and further in view of U.S. Patent 5,878,220 issued to Jeffrey C. Olkin et al. ("Olkin et al.") Applicant respectfully disagrees with this rejection.

Claims 18, 21 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Applicant's Admitted Prior Art in view of Sheard and Humpleman, as applied to Claim 1 above, and further in view of non-patent document "The Gemini Telescope Control System" by Taylor et al. ("Taylor et al."). Applicant respectfully disagrees with this rejection.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180

U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The amended independent claim 1 includes the major two components within an automation system, namely an engineering system and a runtime system. Furthermore, amended independent claim 1 includes a remote Internet Client. All known automation systems use a proprietary communication between the engineering system and the runtime system. According to the present invention, a different approach is used by converting control data designated for the runtime system into a format that can be read by standard Internet clients. The runtime system is connected with a remote Internet Client via an appropriate network, stores the converted data and provides the converted data for the Internet Client. The runtime system can also translate the converted data for use within the runtime system.

The Examiner cited Sheard as allegedly teaching the invention substantially. Applicant respectfully disagrees. Sheard does neither disclose nor mention an automation system consisting of an engineering system and a runtime system. Thus, Applicant believes that a person skilled in the art would not consider Sheard in the specific circumstance because Sheard is not even remotely related to automation technology. At best Sheard discloses a system that converts data from a first system 33 to a second system 31. Citing Humpleman, the Examiner stated that such a conversion could use the XML form to make it available for Internet Clients.

However, as stated above, an automation system consists of different types of components, namely an engineering system and a runtime system. If an external

Internet Client is coupled with the runtime system, a person skilled in the art would at best, assuming such a person would consider Sheard or Humplemann which Applicant does not concede, only provide for a conversion between the runtime system and the Internet Client because the prior art does not teach anything else. Sheard in particular teaches to leave the communication between the applications #1-#4 and the respective adapters 34a-d unaltered. Therefore, a person skilled in the art would not provide for a data conversion between the engineering system and the runtime system. Hence, Sheard clearly teaches away from the subject matter of the present independent claims.

In summary, the prior art cited does not render the present independent claims obvious. Applicant respectfully submits that the dependent Claims are allowable at least to the extent of the independent Claims to which they refer, respectively. Thus, Applicant respectfully requests reconsideration and allowance of the dependent Claims. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and does not concede that the Examiner's proposed combinations are proper.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of all pending Claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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